



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: David WHYTE et al.

Title: NOVEL KINASES

Appl. No.: 10/618,941

Filing Date: July 15, 2003

Examiner: Monshipouri, Maryam

Art Unit: 1653

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is a response to the restriction requirement set forth in the Office Action mailed on August 9, 2005. By the attached petition for an extension of time, Applicants have extended the due date for this response until December 9, 2005. Accordingly, the response is timely.

***Applicants hereby elect, with traverse, Group I (claims 1-5 & 26-29) and Group 32 (SEQ ID NO: 99) for examination.***

As a basis for traversal, Applicants submit that the Examiner failed to establish a need for restriction. The criteria for a proper restriction requirement, according to MPEP § 803, are (1) that the inventions must be independent or distinct as claimed, and (2) that there must be a serious burden on the Examiner to examine the entire application. In this case, the Examiner has failed to demonstrate that a more serious examination burden exists absent restriction. The requirement to elect a single sequence runs counter to the PTO's own policy that "up to ten (10) independent and distinct nucleotide sequences [normally] will be examined in a single application without restriction," to aid the biotechnology industry "without creating an undue burden on the Office." See *Examination of Patent Applications*

*Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996) and MPEP 803.04. The Office has failed to articulate any justification for suspending that policy in this case. In particular, the Office has not established that the sequences in this application are any more difficult to examine than those in a "normal" biotechnology case, thereby making it unreasonable to examine more than a single sequence. Accordingly, Applicants respectfully request withdrawal or revision of the restriction requirement.

An early favorable action on the merits is awaited.

The Commissioner is hereby authorized to charge any additional fees that may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

By



Date December 9, 2005

FOLEY & LARDNER  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5143  
Telephone: (202) 672-5475  
Facsimile: (202) 672-5399

Beth A. Burrous  
Attorney for Applicant  
Registration No. 35,087